

claim 4. Support for these amendments can be found, for example, in the specification at page 5, lines 9-14, and in canceled claim 4. Accordingly, claims 1-3, and 5-18 are currently pending.

No new matter has been added by this proposed amendment nor does this amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. All of the elements and their relationships now claimed were earlier claimed in the claims as examined. Therefore, this Amendment should allow for immediate action by the Office. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

**II. Rejections Under 35 U.S.C. § 103**

The Office has maintained the rejection of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,074,438 ("Lim") in view of U.S. Patent No. 5,230,710 ("Akram") for the reasons set forth at pages 2-4 of the Final Office Action. Applicant respectfully traverses this rejection.

The Office carries the initial burden of establishing a prima facie case of obviousness. In so doing, the Office must demonstrate that three basic criteria have been met, including that the Office point to some suggestion or motivation to modify the reference or to combine reference teachings. M.P.E.P. § 2143. For the reasons of record, as well as those emphasized below, Applicants respectfully submit that the Office has failed to show that the cited references, taken individually or combined, provide the motivation needed to make the selections and combinations suggested by the Office.

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For example, Applicant respectfully submits that nothing in either reference would have provided the motivation for selecting the at least one oxidation base recited in independent claims 1, 13, and 18, as amended above, from the multitude of optional additional components disclosed by Lim, which are disclosed in an extensive laundry list of components that begins on column 5 and ends on column 7 of Lim.

Moreover, this extensive list contains at least five different classes of dye intermediates and/or couples, at least four of which contain no components which read on the at least one oxidation base recited in the claims. Thus, a vast majority of these optional ingredients do not fall within the scope of Applicant's claimed at least one oxidation base and many, such as the pyrimidine derivatives and 2-hydroxyethyl-p-phenylenediamine, are actually excluded from Applicant's claims. See column 5, lines 30-31 and column 6, lines 46-65. Furthermore, as acknowledged by the Office, Lim "does not exemplify a composition, process or kit as claimed, particularly which contains or uses the claimed coupler or which additionally comprises the p-aminophenol oxidation bases." *Office Action*, p. 3. Thus, no examples are present in Lim that would guide one of ordinary skill in the art to make the selection suggested by the Office.

In an attempt to advance prosecution, Applicant has amended the independent claims to recite that the at least one oxidation base is chosen from the oxidation bases recited in claim 4 as originally filed, i.e., 4-amino-3-methylphenol, 4-amino-3-fluorophenol, 4-amino-3-hydroxymethylphenol, 4-amino-2-methylphenol, 4-amino-2-hydroxymethylphenol, 4-amino-2-methoxymethylphenol, 4-amino-2-aminomethylphenol, 4-amino-2-( $\beta$ -hydroxyethylaminomethyl)phenol and 4-amino-2-fluorophenol, and an addition salt thereof with an acid. Applicant respectfully submits that nothing in Lim

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would have led one of ordinary skill in the art to select one of Applicant's claimed oxidation bases from the multitude of optional additional components disclosed in Lim, the vast majority of which fall outside the scope of the claimed at least one oxidation base.

As emphasized in Applicant's previous response, the Federal Circuit recently emphasized the requirement for specificity for showing that the prior art suggests the modification or combination alleged by the Office. *See, e.g., In re Sang-Su Lee*, 277 F.3d 1338, 1433 (Fed. Cir. 2002). In this case, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

*Id.* (internal citations and quotation omitted) (emphasis added).

In the present case, Applicant submits that nothing in Lim or Akram would have led one of ordinary skill in the art to select at least one of the claimed oxidation bases recited in the present claims in place of any of the other multitude of optional components disclosed in Lim. In fact, the odds of making such a selection from the teachings of Lim and Akram would be quite low simply based on the number of optional components that fall outside the scope of the presently claimed at least one oxidation base. The lack of specific guidance to select the claimed at least one oxidation base only serves to increase these odds.

Further, not only do Lim and Akram fail to provide the motivation for making the specific selection suggested by the Office, but there is also evidence of record that one of ordinary skill in the art would not have a reasonable expectation of success for

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making this selection. As the Office is well aware, the prior art must also provide some teaching that one of ordinary skill in the art would have a reasonable expectation of success when combining the references. M.P.E.P. § 2143. This requirement becomes even more critical where the invention involves the unpredictable arts, as in the case of hair dyes. See Zviak, THE SCIENCE OF HAIR CARE, at 271-72 (Charles Zviak ed., 1986).

In this regard, Applicant respectfully directs the Office's attention to Examples 3 and 4 of the present specification. As reported on page 18 of the present specification, the composition of Example 3 comprising an oxidation base outside the scope of the independent claims (para-aminophenol) and a claimed coupler, was compared with the composition of Example 4 comprising an oxidation base within the scope of the independent claims (4-amino-3-methylphenol) and the same claimed coupler as Example 3. The table set forth on page 18 shows that the comparative composition of Example 3 gives a coloration that is much less fast with respect to the action of shampooing than the colorations obtained using the composition of Example 4.

What is particularly significant about this comparison is that the para-aminophenol oxidation base of comparative Example 3 is not only one of the multitude of oxidation bases disclosed as optional additional components in Lim, but it is also a member of the only class of dye intermediates and/or couples that contains any components that could read on the claimed at least one oxidation base. Given the general unpredictability of the hair dye art, and the results set forth on page 18 of the present specification, there would not even be an expectation of success for choosing one para-aminophenol derivative from among the para-aminophenol derivatives disclosed in Lim, let alone simply choosing one from among the many disclosed in Lim.

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For at least these reason, Applicants respectfully submit that a prima facie case of obviousness has not been established, and request that the § 103(a) rejection be withdrawn.

III. **CONCLUSION**


Applicant respectfully requests the entry of the proposed Amendment, the reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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